



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re the Application of:

Brown, et al.

Serial No.: 10/646,256

Filed: August 22, 2003

Atty. File No.: 4220-46-C1-1

For: PRENYLATION INHIBITORS
AND METHODS OF THEIR
SYNTHESIS AND USE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Applicants, through their attorneys, respectfully petition for an extension of time under 37 CFR § 1.136(a) of four months to respond to the Restriction Requirement mailed on January 16, 2004, with respect to the above-identified application, thereby extending the period for response from February 16, 2004, to June 16, 2004.

Enclosed is a check in the amount of \$1,480.00 as payment of the extension fee. Please credit any overpayment or debit any underpayment to Deposit Account No. 19-1970.

Respectfully submitted,

SHERIDAN ROSS P.C.

06/24/2004 BABRAHA1 00000064 10646256

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1480.00 DP

By:

Gary J. Connell

Registration No. 32,020

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Date:

June 16, 2004

CERTIFICATE OF MAILING
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA VA 22313-1450 ON JUNE 16, 2004.
SHERIDAN ROSS P.C.
BY:



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Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

) Group Art Unit: 1625

)

) Examiner: Morris, P.

)

RESPONSE TO RESTRICTION
REQUIREMENT

CERTIFICATE OF MAILING

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COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA
VA 22313-1450 ON JUNE 16, 2004.

SHERIDAN ROSS P.C.

BY: 

Dear Sir:

This response is filed in response to a Restriction Requirement having a mailing date of January 16, 2004. Enclosed herewith is a request for a four month extension of time to extend the time for response from February 16, 2004 to June 16, 2004. No additional fees are believed to be due in connection with this response, but if fees are due, please debit Deposit Account No. 19-1970.

The Examiner restricted the claims into six groups as follows:

Group I, claims 6-11 drawn to compounds having an amide linking group

Group II, claims 12-17 drawn to compounds having a pyrrolidine group in the backbone

Group III, claims 18-21 drawn to three truncated compounds that have no terminal amide group

Group IV, claims 32-42 drawn to methods of using compounds in Group I

Group V, claims 43-53 drawn to methods of using compounds in Group II

Group VI, claims 54-62 drawn to methods of using compounds in Group III.

The Examiner further stated that in the event Group III is elected, a further election between the three different structures included in the Markush group of that claim was required.

Additionally, the Examiner indicated that if Group I, II or III is chosen, a method of use directed to a single disease state will be examined with the elected compound.

Applicants provisionally elect, with traverse, to prosecute the claims of Group I (Claims 6-11), directed to compounds having an amide linking group. With regard to Groups I-VI, the Patent Office may require restriction if two or more "independent and distinct" inventions are claimed in one application. However, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. Section 803. Applicants submit that a thorough search for Group I should also include the subject matter of Groups II-VI. Therefore, the Examiner is respectfully requested to withdraw the restriction between Groups I-VI.

In addition, Applicants elect treatment of solid tumors (p. 14, ll. 4-5) as a specific disclosed disease for examination, and alternatively, if the Examiner does not accept the scope of solid tumors as being a specific disclosed disease, Applicants elect colon cancer (p. 14, l. 6) as the specific disclosed disease.

In support of Applicants' identification of treatment of solid tumors as a specific disclosed disease, the compounds of the present invention function by inhibition of prenylation. The usefulness of the compounds in treating a disease such as cancer depends on the ability of the compounds as prenylation inhibitors that inhibit prenylation of, for example, Ras and Rho family proteins. Since the role of such proteins in solid tumors is well documented, Applicants submit that for purposes of examination of a disease in connection with the compounds of Group I, solid tumors should be examined.

Respectfully submitted,

SHERIDAN ROSS P.C.

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